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09/265,926 03/11/99 DALES

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EXAMINER

BERCH, M

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

03/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/265,926

Applicant(s)

Dates

Examiner
Mark L. Berch

Group Art Unit
1624



☒ Responsive to communication(s) filed on Feb 5, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 5-7, 10-14, and 21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5-7, 10-14, and 21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 302,644.

Note Formula I. R_3 as amino is clearly preferred, as it is the sole choice seen in the final product. As for R_1 , two choices are given as preferred at page 7, line 7, viz, methyl and ethyl. Claim 5 has the methyl. For R_2 , there is a list on page 7, lines 8-9, which has 3 or 6 items in it, depending on how one counts, one of which is chloro. Thus, by using the explicitly set forth preferred choices for the variables, a Markush of $2 \times 3 = 6$ or $2 \times 6 = 12$ (depending again on how the list on page 7, lines 8-9 is counted) is present. A Markush group of either size is deemed to be an anticipation of all 6 or 12. Note *In re Petering*, 133 USPQ 275; *In re Sivaramarishnan*, 213 USPQ 441 (which had a Markush group of around 70); *In re Schaumann*, 197 USPQ 5.

Applicants' traverse on this point is unpersuasive. With regard to R_1 , the methyl and ethyl are the only ones named, and hence are clearly preferred. Moreover, that yields two choices, not three: Both methyl and both ethyl. There is no methyl/ethyl choice. The formula gives the same R_1 for both positions. The definition says what R_1 is, and does not say that they are independent of each other. Further,

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the method given in the reference does not provide for mixed species. Hence, there are just the two choices of esters: dimethyl and diethyl.

The comments on R_2 are not persuasive. There is just the small list. Even if there were 10 present, 2×10 is still 20, the size the the group in *Petering*, and substantially smaller than the 70 of *Sivaramarishnan*. Further, only three are named, and hence three would be understood as preferred. The comments on R_3 cannot be agreed with. There are other choices, but since this R_3 as amino is the one actually seen in every final product, it would be understood as preferred.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 -7 and 10-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 302,644.

The reasons were given previously; the traverse on this point is unpersuasive. Applicants have simply not come to terms with the huge number of differences. Applicants have not replicated the prior art process at all. As an example, in the reduction step, there were four differences (labeled D, E, F, and G) between the actual procedure used in the reference and that done in the declaration. The wrong solvents and temperatures were used; the prior art purification step was omitted.

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Also, the comments about one aspect of point A are not agreed with. Claim 10 recites no transesterification step. The prior art is not a transesterification. But the inexplicable use of the methoxide rather than the ethoxide means that a transesterification was done. While it is true that "comprises" means that transesterification is not barred, it is an extra step not required by the claims other than 21. Since it is not present in the prior art process either, this issue even applies to claim 21, since the prior art process was not properly duplicated in this regard.

As was noted previously, the prior art obtained a product which could be crystallized from n-butanol, whereas applicants, having made many changes, got a product which they could not crystallize from the same solvent. That is further proof that the prior art process was not properly replicated.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

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the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

A handwritten signature in black ink, appearing to read "Mark L. Berch". The signature is written in a cursive, flowing style.

Mark L. Berch

Primary Examiner

Group 1620 - Art Unit 1624

March 15, 2001